

APPLICATION NO.: 09/552,879

ATTY. DOCKET NO. 47004.000056
AMENDMENT AFTER FINAL: MARCH 25, 2005**REMARKS**

This Amendment After Final is submitted in response to the Office action mailed on February 10, 2005 ("Office Action"), in the above-referenced patent application. As explained in detail herein, the Applicants respectfully submit that the holding of finality of the Office Action is premature under the present circumstances, and thus request withdrawal thereof. The Applicants also believe that the claims remaining after this amendment are allowable, and allowance thereof is respectfully requested.

STATUS OF THE CLAIMS

Claims 1-40 were pending in the application at the time of the Office Action. By this amendment, claims 1-20 and 35-40 are cancelled without waiver or prejudice to pursue them in a continuing application. In order to advance prosecution and distill the issues in this application, the Applicants are canceling all but claims 21-34. The Applicants hope that this will facilitate a meaningful, focused dialogue between the Examiner and the Applicants' representative on the merits of the remaining claims.

Claim 21 has been amended to recite that the search results comprise a first set of investment funds that do not satisfy all of the user-selected quantitative search criteria, but which satisfy the overall user-defined criteria based on the combination of the user-selected weighting criteria and the user-selected quantitative criteria. This feature was originally recited, in substance, in dependent claim 27 as the "second" set of search results. Claim 27 has been amended to eliminate duplicative claim language. Similar amendments have been made to independent claim 28 and dependent claim 34. No new matter is believed to be added by these amendments.

REQUEST TO WITHDRAW FINALITY OF OFFICE ACTION

The M.P.E.P. sets forth guidelines for determining when an action on the merits shall be final:

APPLICATION NO.: 09/552,879

ATTY. DOCKET NO. 47004.000056
AMENDMENT AFTER FINAL: MARCH 25, 2005

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. 1.97(c) with the fee set forth in 37 C.F.R. 1.17(p).

M.P.E.P. § 706.07(a) (emphasis added).

In the present case, the Office Action rejects all of the pending claims under a new ground of rejection based on a previously-uncited prior art reference. Specifically, the Examiner now relies upon Kurtzman in combination with Levine to purportedly illustrate the feature of "the use of the technique of weightable search information comprising user-selected quantitative search criteria and user-selected weighting criteria." Office Action, p. 2. This combination allegedly solves Levine's failure to "explicitly disclose" this element of the claims. *Id.* In the previous rejections of these claims, however, the Examiner relied upon interpretations of Levine to show that the weighted search criteria element of the present claims was illustrated in Levine itself. *See, e.g.,* August 20, 2004 Office action, pp. 4-5. This interpretation is dropped in the present Office Action. As such, the Examiner has changed the basis of the rejection, and added a new reference that was not applied in any prior Office actions.

The new grounds of rejection was not necessitated by an amendment to the claims, because no amendments were made in the Applicants' prior reply. The new grounds of rejection also was not based on information submitted in an information disclosure statement submitted during the period set forth in 37 C.F.R. § 1.97(c), because no IDS was filed during that period. In view of the foregoing facts, and in consideration of the requirements set forth in M.P.E.P. § 706.07(a), it is clearly premature to make the present Office Action final. Therefore, the Applicants respectfully request that the Primary Examiner reconsider and withdraw the finality of the Office Action. (Consideration by the Primary Examiner is specifically required by M.P.E.P. § 706.07(d).)

APPLICATION NO.: 09/552,879

ATTY. DOCKET NO. 47004.000056
AMENDMENT AFTER FINAL: MARCH 25, 2005**THE CLAIM REJECTIONS**

Claims 1-20 and 35-40 stand rejected, but have been cancelled by this amendment. As such the Examiner's rejections of these claims are now moot. The remainder of this reply addresses the rejection of remaining claims 21-34.

Claims 21-23, 27-30 and 34 stand rejected under 35 U.S.C. § 103(a) over Levine (U.S. Pat. No. 6,233,566) in view of Kurtzman (U.S. Pat. No. 6,144,944) and Reese (U.S. Pat. No. 6,370,516). Dependent claims 24 and 31 stand rejected under the forgoing combination, taken in further view of O'Shaughnessy (U.S. Pat. No. 6,317,726). Dependent claims 25, 26, 32 and 33 are rejected under the Levine/Kurtzman/Reese combination taken in further view of Hambrecht (U.S. Pat. No. 6,629,082).

The primary issue with respect to the rejection is whether the cited references render obvious the feature of "a first set of investment funds that do not satisfy all of the user-selected quantitative search criteria, but which satisfy the overall user-defined criteria based on the combination of the user-selected weighting criteria and the user-selected quantitative criteria," as recited in claims 21 and 28. The Examiner has acknowledged that neither Levine nor Kurtzman teaches or suggests this feature of the claims, and so the Examiner combined Reese with these references to allegedly render the claims obvious. The Examiner primarily argues that the motivation for the combination is "for the purpose of permitting the evaluation of degrees of fit to one's investment search criteria for the purpose of saving a user's time through a highly automated search tool capable of producing search results which partially satisfy a user's search and weighting criteria." Office Action, p. 5. The Examiner cites to Reese at column 1, lines 59-65 in support of this combination. The Applicants respectfully traverse this rejection on the grounds no *prima facie* case of obviousness exists because the combination of references is improper, as explained below.

The courts and the Patent Office have recognized various prohibitions against combining references to reject a claim under 35 U.S.C. § 103(a). Among these are rules

APPLICATION NO.: 09/552,879

ATTY. DOCKET NO. 47004.000056
AMENDMENT AFTER FINAL: MARCH 25, 2005

against combining references when the references teach away from the proposed combination (M.P.E.P. § 2145(X)(D)); when the combination would render one or both references unsatisfactory for its stated purpose (*In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984); and M.P.E.P. § 2143.02); and when the combination would change the reference's principle of operation (*In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); and M.P.E.P. § 2143.02). Furthermore, the motivation to combine the references can not be based upon the teachings of the invention under examination. M.P.E.P. § 2145(X)(A) (citing *In re McLaughlin*, 443, F.2d 1392, 1395 (C.C.P.A. 1971)). The Applicants respectfully submit that the Examiner's rejection violates all of these prohibitions, and each violation, alone, renders the combination improper.

The Reese patent describes a type of prior art searching system that uses "screens" to sort through data. Reese at col. 2, ll. 4-12. These so-called "screen" systems apply search criteria as a filter to the entire universe of data. The results of the "screen" comprise all of the data meeting the search criteria. *Id.* The Levine reference describes *exactly* this type of "screen" system. For example, at column 14, lines 32-64, Levine describes an investor using rules to search for available loans. Examples of these rules include "only loans made to borrowers having a FICO score greater than 600 and an interest rate of 13% or greater." Levine, col. 14, ll. 59-60. The Levine system then notifies the user when loans meeting these criteria are posted for sale. *Id.* at ll. 62-64. Similarly, Kurtzman discloses a system in which a single advertisement is generated for each request. See Kurtzman at col. 3, ll. 57-60 ("The ad server 100 ... provides a flexible and efficient system for selecting the best fit advertisement to show a user ...").

Although the Examiner alleges that there is a motivation to combine these references, it is clear from reading the Reese reference that it would be improper to do so. The first basis for finding the combination improper is that Reese specifically states that the prior art "screen" systems such as those in Levine "*are not applicable to the present invention.*" Reese, col. 2, ll. 13-15 (emphasis added). *As such, Reese specifically*

APPLICATION NO.: 09/552,879

ATTY. DOCKET NO. 47004.000056
AMENDMENT AFTER FINAL: MARCH 25, 2005

teaches against being combined with the Levine system, making the combination improper. See M.P.E.P. § 2145(X)(D).

The second basis for finding the combination improper is that it would render Reese unsatisfactory for its stated purpose. The entire purpose of Reese is to move away from requiring the user to input *any* sort of user-selected search criteria at all. This is made abundantly clear in the Reese at column 2, lines 13-29, where Reese states that "[t]he only input required by the user is the company name or stock selection ID," and that "[a]ll the user has to do is input the company name or security ID." This feature, Reese claims, makes it "entirely different from the prior art." *Id.*, col. 2, ll. 28-29. In contrast, the portions of Levine that the Examiner seeks to combine with Reese require the user to enter relatively *elaborate* data to perform the search. In light of Reese's stated purpose of *eliminating* the user's need to enter elaborate search criteria, *combining Reese with Levine in this manner to incorporate such elaborate search criteria into Reese would necessarily result in rendering Reese unsatisfactory for its stated purpose.* This renders the combination of Reese and Levine improper. *See In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984); and M.P.E.P. § 2143.02. Of course, these factors also demonstrate that Reese teaches away from a combination with Levine or Kurtzman.

The third basis for finding the combination improper is that it would change the principle of operation of the combined reference. If one were to combine Levine with Reese to arrive at the present claimed invention, one would force the Reese device to operate by receiving multiple complex input criteria (the weightable search criteria), *which would change Reese's principle of operation, which is to enter only the company name or stock selection ID.* Reese at col. 2, ll. 13-29. This also renders the combination improper. *See In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); and M.P.E.P. § 2143.02. These factors also demonstrate that Reese teaches away from a combination with Levine or Kurtzman.

APPLICATION NO.: 09/552,879

ATTY. DOCKET NO. 47004.000056
AMENDMENT AFTER FINAL: MARCH 25, 2005

The Examiner addressed some of the foregoing arguments in the Office Action.¹ Specifically, with regard to the fact that Reese teaches away from a combination with Levine, the Examiner alleges that *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983)² supports the proposition that "the 'teaching away' doctrine has limited, narrow technical validity of a common sense variety." Office Action, pp. 11-12. The Examiner further alleged that "[i]n this case, the alleged teaching away is technically unrelated to the section of Reese cited in Applicant's argument," and that "[t]he method step ... used by the examiner from Reese is an independent method concept which is freely applicable in the Levine art ... because it is a specific, narrow technique [sic] with which an ordinary practitioner of the art would have found it obvious to modify the Levine teaching for the purpose of Applicant's invention. Such a practitioner would not have been confused by the remainder of the teachings [of Reese.]" *Id.* at 12.

The Examiner's argument is insufficient for two reasons. First, the argument is directly contrary to the actual holdings of the *W.L. Gore* case. Second, it appears to improperly base the motivation to combine the references on the Applicant's own disclosure.

With regard to *W.L. Gore*, this case actually stands for the proposition that the Examiner must consider the reference as a whole, and can not pick and choose which portions of the teachings to combine, while ignoring those portions that teach away from the combination. This interpretation of *W.L. Gore & Associates* is explicitly set forth in the M.P.E.P. at § 2141.02, under the heading "Prior Art Must be Considered in

¹ The Examiner did not address the second and third bases for rendering the combination improper (*i.e.*, that it would render Reese unsatisfactory for its stated purpose and would change Reese's principle of operation).

² The Examiner does not provide a case citation, and there are at least five cases captioned "*W.L. Gore & Associates v. Garlock, Inc.*" For purposes of this analysis, the Applicants assume that the Examiner is referring to the dispositive Federal Circuit case.

APPLICATION NO.: 09/552,879

ATTY. DOCKET NO. 47004.000056
AMENDMENT AFTER FINAL: MARCH 25, 2005

its Entirety, Including Disclosures That Teach Away From the Claims." In fact, the *W.L. Gore* Court actually found that the district court in that case had *erred* when it failed to consider the prior art reference *in its entirety*: "In its consideration of the prior art, however, the district court erred in ... considering the references in less than their entireties, i.e., in disregarding disclosures in the references that diverge from and teach away from the invention at hand." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983) (emphasis added). In support of this finding, the *W.L. Gore* Court cited to *In re Kuderna*, 57 C.C.P.A. 1078 (C.C.P.A. 1970), in which the Court of Customs and Patent Appeals stated that "[w]e must approach the issue of patentability in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of first one and then another of the isolated teachings in the art." *In re Kuderna* at 1083-1084.

It is clear from the *W.L. Gore* and *Kuderna* cases and the Patent Office Practice guidelines that the Examiner *must* consider each 103(a) reference as a whole. Ironically, however, the Examiner seeks to use the *W.L. Gore* case in support of doing just the *opposite*, as evidenced by the Examiner's comments that "the method step ... is an independent method concept which is freely applicable in the Levine art," and that "a practitioner would not have been confused by the remainder of the teachings and the various problems Reese discusses and overcome with various elements of his teaching." Here, the Examiner simply separates out one portion of Reese and draws the unsupported conclusion that a practitioner would "not have been confused,"³ by the remaining disclosure.

The Applicants respectfully submit that the Examiner's argument is unconvincing because there is ample evidence to show that Reese has no applicability

³ The source of the Examiner's test of whether a practitioner would have been "confused" is also unclear, as it does not appear to be derived from the *W.L. Gore* case.

APPLICATION NO.: 09/552,879

ATTY. DOCKET NO. 47004.000056
AMENDMENT AFTER FINAL: MARCH 25, 2005

to Levine, and that significant compatibility issues would strongly deter an ordinary practitioner from combining the references. As noted in more detail above, in addition to flatly stating that the prior art "screen" systems such as those in Levine "*are not applicable to the present invention*," Reese, col. 2, ll. 13-15 (emphasis added), there is ample evidence to show that combining Reese with Levine would cause Reese to be unsatisfactory for its intended purpose, and would actually change Reese's principle of operation by converting it from a system in which the user enters only a company name or stock selection ID into a system in which the user enters multiple quantitative and weighting criteria. Indeed, an ordinary practitioner would find the combination of Reese with Levine to be replete with contradictions and incompatibility. As such, when Reese is *taken as a whole*, as it must be, there is clearly no motivation to combine these references.

A further problem with the Examiner's argument arises from the allegation that the "method step ... from Reese is ... freely applicable in the Levine art ... because it is a specific, narrow technique [sic] with which an ordinary practitioner of the art would have found it obvious to modify the Levine teaching for the purpose of the Applicant's invention." Here, the Examiner's stated motivation to combine the references is "for the purpose of the Applicant's invention." As such, it is clear that the Examiner is actually basing the motivation to combine the references on the applicant's disclosure itself ("for the purpose of the Applicant's invention"). This is impermissible hindsight reasoning that is prohibited by well-established case law and the M.P.E.P. See, e.g., *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) ("It is impermissible to use the claimed invention as an instruction manual or 'template' to pieced [sic] together the teachings of the prior art so that the claimed invention is rendered obvious."); *In re McClaughlin*, 443 F.2d 1392, 1395 (C.C.P.A. 1971); and M.P.E.P. § 2145(X)(A). As such, this motivation can not serve as the basis to combine Reese with Levine, and provides no legally-recognized basis to contradict the many factors that point against combining the references.

APPLICATION NO.: 09/552,879

ATTY. DOCKET NO. 47004.000056
AMENDMENT AFTER FINAL: MARCH 25, 2005

In summary, the Reese patent provides various disclosures that clearly teach away from any combination with Levine or Kurtzman, demonstrate that the combination would render Reese unsatisfactory for its stated purpose, and show that the combination would change Reese's principle of operation. These reasons, separately or combined, render the combination improper. Furthermore, the Examiner's attempt to extract the "scorecard variable" feature from the otherwise uncombinable Reese reference and apply it to Levine is improper under the clear precedent of *W.L. Gore*, and contradicts the mandates of M.P.E.P. § 2141.02. The Examiner's further reliance on the Applicants' own disclosure as the motivation to combine the references is also improper. As such, the references can not be combined to render each and every claim limitation obvious, and therefore there is no *prima facie* case of obviousness with respect to the feature of "a first set of investment funds that do not satisfy all of the user-selected quantitative search criteria, but which satisfy the overall user-defined criteria based on the combination of the user-selected weighting criteria and the user-selected quantitative criteria." For all of the foregoing reasons, the Applicants respectfully request reconsideration of the rejection of claims 21-34 and allowance thereof.

CONCLUSION

The Applicants respectfully submit that the current claims are in condition for allowance. Withdrawal of the holding of finality of the Office Action, entry of the following amendments, and reconsideration of the claim rejections are respectfully requested. If the Examiner believes that prosecution might be advanced by discussing the application with Applicants' counsel, in person or by telephone, Applicants' counsel would welcome the opportunity to do so.

This reply is submitted within the 3-month shortened statutory period, and therefore no fees are believed to be due in connection herewith. In the event any fees


APPLICATION No.: 09/552,879

ATTY. DOCKET NO. 47004.000056

AMENDMENT AFTER FINAL: MARCH 25, 2005

are required, however, the Commissioner is hereby authorized to charge such fees to the undersigned's deposit account No. 50-0206.

Respectfully submitted,
HUNTON & WILLIAMS

By: 
Michael P.F. Phelps
Registration No. 48,654

Hunton & Williams
1900 K Street, N.W., Suite 1200
Washington, D.C. 20006-1109
Telephone (202) 955-1500
Facsimile (202) 778-2201

Dated: March 25, 2005